

Atty Matter No. 0276492
Atty Reference No. 23521-0107

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re Patent Application of:)	
)	
Vassilios Papadopoulos et al.)	
)	
Application No. 09/047,652)	
)	Group Art Unit: 1642
Filed: March 25, 1998)	
)	Examiner: M. Davis
For: PERIPHERAL-TYPE BENZODIAZEPINE)	
RECEPTOR: A TOOL FOR DETECTION,)	
DIAGNOSIS, PROGNOSIS, AND)	
TREATMENT OF HUMAN BREAST)	
CANCER)	

17
02/20/01

REPLY PURSUANT TO OFFICIAL ACTION IMPROPERLY HOLDING OCTOBER 12, 2000 REPLY NON-RESPONSIVE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This Reply is responsive to the January 18, 2001 letter. In response to this Official Action, which this should not be necessary, kindly cancel Claims 58-62. As a result of this amendment, all the current are directed to an isolated, biogenetically pure antisense oligonucleotide that possesses a structure complementary to PBR receptor DNA sequences, and which inhibits the expression of the PBR gene.

In the most recent Official Action, the Examiner improperly held Applicants' October 12, 2000 Reply non-responsive. Particularly, she asserted that all the claims submitted with the most recent Reply are directed to a non-elected invention. However, this is not the case.

Indeed, Applicants' previous Reply dated December 15, 1999 contained Claim 50 directed to an antisense oligo complementary to PBR RNA or DNA that inhibits the expression of PBR. Moreover, the claim was treated on the merits and rejected in the April 12, 2000 Official Action under §112, first paragraph, and under §103 based on prior art.

In response to such rejection, Applicants narrowed their claims such that they are directed to antisense oligos complementary to PBR sequences having express support in the disclosure. Moreover, when they submitted such amendments, Applicants were not under

REPLY TO OFFICIAL ACTION

U.S. Serial No. 09/047,652

Page 2

final rejection. Accordingly, it is not seen how the previous Amendment was improper as quite clearly, Applicants submitted a Reply with numerous claims corresponding to an invention previously elected and treated on the merits. While it is understood that the Examiner perhaps did not search for these specific sequences, they were part of the disclosure. Also, the disclosure made clear that these sequences correspond to PBR (see pp. 15-16 of the application).

Accordingly, in construing the claims, it should have been apparent that antisense oligonucleotides corresponding to these sequences constituted subject matter directed to an invention already searched and examined. Indeed, it is unclear how the Examiner could have construed the claimed PBR antisense oligos absent a search of SEQ ID NOS:1 or 2.

However, in any event, Applicants did not submit an improper Reply.

If the Examiner has any questions with respect to this application, please contact the undersigned attorney of record at the telephone number listed below.

Respectfully submitted,

PILLSBURY WINTHROP L.L.P.

By: 

Robin L. Teskin

Registration No. 35,030

PILLSBURY WINTHROP L.L.P.
1100 New York Avenue, N.W.
Ninth Floor, East Tower
Washington, D.C. 20005-3918
(202) 861-3000 Telephone
(202) 822-0944 Facsimile

Date: February 20, 2001

FROM
Intellectual Property Group of
Pillsbury Winthrop LLP
Attorneys at Law
1100 New York Avenue, NW
Ninth Floor
Washington, DC 20005-3918
Telephone: (202) 861-3000

Our Facsimile #: (202) 822-0944

FACSIMILE TRANSMISSION

FAX RECEIVED

TO: UNITED STATES PATENT AND TRADEMARK OFFICEFACSIMILE #: (703) 308-4227No. Pages (Including this page) 5 FAX Opr: K. Hutchison

GROUP 1600

IF YOU DO NOT RECEIVE CLEARLY ALL PAGES, PLEASE CONTACT US IMMEDIATELYBy Telephone AT: (202) 861-3735 (local)
or (202) 861-3667 (local)

->->->

USPTO:PLEASE ACKNOWLEDGE CLEAR RECEIPT OF ALL PAGES INDICATED
ABOVE BY FAXING THIS PAGE BACK TO ONE OF OUR FACSIMILE
NUMBERS STATED ABOVE

In re PATENT APPLICATION of

Inventor(s) Vassilios Papadopoulos et al.Appln. No. 09/047,652Group Art Unit: 1642Examiner: M. Davisseries code ? ↑ serial no.Filed: March 25, 1998Atty. Dkt. PM 0276492

M#

TITLE: Peripheral-Type
Benzodiazepine Receptor: A
Tool for Detection,
Diagnosis, Prognosis, and
Treatment of Human Breast
CancerDate: February 20, 2001Name or type of signed paper being transmitted:
Reply to Official ActionMESSAGE:

Please see the attached Reply to the January 18, 2001 Official Action.

Thank you.

(ATTN: Atty/Sec.: Transmit only one paper herewith. For papers not acceptable by fax, see back side or IAN
Forms Directory PAT-286 Rear. Do not file originals but fasten them in our file (left side) with
this sheet and fax receipt on top. Do NOT send the originals nor a confirmation copy to the PTO.)

CERTIFICATE OF FACSIMILE TRANSMISSIONI hereby certify that this paper is being facsimile transmitted to the Patent
and Trademark Office on the date shown below.Name Robin L. Teskin Sig. [Signature] Date February 20, 2001082137/0276492

C# / M#

Inventor(s): Vassilios Papadopoulos et al.

Appln. No.: 09 | 047.652

Series Code ↑

Serial No. 7

Filed: March 25, 1998

Hon. Commissioner of Patents
Washington, D.C. 20231

Group Art Unit 1642

Examiner: M. Davis

Atty. Dkt. PM 0276492 | 23521-0107

MS

Client Ref

Appln. Title: Peripheral-Type Benzodiazepine Receptor: A Tool for Detection, Diagnosis, Prognosis, and Treatment of Human Breast Cancer

Sir:

REPLY/AMENDMENT/LETTER GROUP 1600

Date: February 20, 2001

This is a reply/amendment/letter in the above-identified application and includes the herewith attachment of same date and subject which is incorporated hereinto by reference and the signature below is treated as the signature to the attachment in absence of a signature thereto.

FEE REQUIREMENTS FOR CLAIMS AS AMENDED

FEE REQUIREMENTS FOR CLAIMS AS AMENDED										
1. Small Entity claim A. <input type="checkbox"/> NOT made B. <input type="checkbox"/> Withdrawn C. <input type="checkbox"/> made herewith D. <input checked="" type="checkbox"/> made previously		For B & C See <u>Required</u> <u>Separate Paper</u> (Pat-256)		Claims remaining after amendment	Highest number previously paid for	Present Extra	Large/Small Entity	Additional Fee	Fee Code Lg/Sm	
2. Total Effective Claims				**minus	0	0	x \$18/\$9 =	+ \$0	103/203	
3. Independent Claims				***minus	0	0	x \$80/\$40 =	+ \$0	102/202	
4. If amendment enters <u>proper</u> multiple dependent claim(s) into this application for <u>first</u> time (leave blank if this is a reissue application)							add	+ \$270/\$135 =	+ \$0	104/204
5. Original due Date: February 18, 2001				<input type="checkbox"/> NONE						
6. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached				(1 mo)	\$110/\$55 =	+ \$0			115/215	
				(2 mos)	\$390/\$195 =				116/216	
				(3 mos)	\$890/\$445 =				117/217	
(Usable <u>only</u> for ≤ 2mo.OA --- 4 mos)				\$1390/\$695=	118/218					
(Usable <u>only</u> for 30 day/1mo.OA --- 5 mos)				\$1890/\$945=	128/228					
7. Enter any previous extension fee paid since above original due date and subtract							- \$0			
8. Extension Fee Attached							+ \$0			
9. If Terminal Disclaimer attached, add Rule 20(d) official fee							+ \$110/\$55	+ \$0	148/248	
10. If IDS attached requires Official Fee under Rule 97 (c),							+ \$180	+ \$0	126	
or if Rule 97(d) Request							+ \$180		126	
11. After-Final Request Fee per rules 129(a) and 17(r)							+ \$710/355	+ \$0	146/246	
12. No. of additional inventions for examination per Rule 129(b)							x \$710/355 ea	+ \$0	149/249	
13. Request for Continued Examination (RCE)							+ \$710/355	+ \$0	1179/1279	
14. Petition fee for								+ \$0		
15. TOTAL FEE ENCLOSED =							\$0			

16. *If the entry in this space is less than entry in next space, the "Present Extra" result is "0".
17. **If the "Highest number previously paid for" in this space is less than 20, write "20" in this space.
18. ***If the "Highest number previously paid for" in this space is less than 3, write "3" in this space.

Our Deposit Account No. 03-3975)

(Our Order No. 082137 | 0276492

C#

144

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Accounting/Order Nos. shown above, for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an Issue fee transmittal sheet is filed.

Query: Is appeal deadline now? If so, file Notice of Appeals separately..

Pillsbury Winthrop LLP
Intellectual Property Group

By Atty: **Robin L. Teskin**

Reg. No. 35,030

1100 New York Avenue, NW
Ninth Floor

Washington, DC 20005-3918

Tel: (202) 861-3000

Atty/Sec: RLT/kmh

Sig:

Fax: (202) 822-0944

Tel: (202) 861-3623

NOTE: File this cover sheet in duplicate with PTO receipt (PAT-103A) and attachments